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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,952	01/31/2002	Heon Lee	10007140-1	4585

7590 08/28/2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

POWELL, WILLIAM A

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 08/28/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,952

Applicant(s)

Lee

Examiner

Wm. A. Powell

Group Art Unit

1765

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on JAN. 31, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- ☐ Of the above claim(s) 0 is/are withdrawn from consideration.
- ☒ Claim(s) 12, 13 is/are allowed.
- ☒ Claim(s) 1-11, 14 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☒ The proposed drawing ~~correction~~, filed on 01/31/02 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Claims 1-11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression, "predetermined," renders these claims indefinite since it is not clear what such may include. The use of "predetermined" reads on a nebulous ^{metal} step conducted prior to the manipulative steps of the claimed invention, hence rendering the present process and product claims unclear in meaning and scope. If applicant, ^{wishes} ~~which has~~ to patent detailed controls over the recited process and product, they should be positively recited. A claim is indefinite where it specifies "predetermined" temperature, etc.--, when such according to applicant's definition merely means determined before hand. Note, *Seagram's & Sons Inc. vs. Mazall*, 84 USPO 180. The claims ^{are} ~~and~~ therefore, considered to be unpatentable under 35 USC 112, second paragraph for the reasons set forth above. They could be clarified by merely canceling said expression.

2. Claim 5 contains the trademark/trade name PYREX. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not

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identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the substrate material and, accordingly, the identification/description is indefinite.

3. Claims 12-13 appear to be in condition for allowance.

Any inquiry concerning this communication should be directed to William A. Powell at telephone number (703) 308-1975.

W.A. Powell/dh
August 26, 2003


WILLIAM A. POWELL
PRIMARY EXAMINER